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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,099	08/07/2003	Robert R. Gallucci	RD27416-2	3376

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EXAMINER	
TRAN, THAO T	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/638,099	GALLUCCI ET AL.	
	Examiner	Art Unit	
	Thao T. Tran	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2004 and 22 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) *3,12-14,20 and 23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-11,15-19,21 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/27/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the Amendments filed 7/27/04 and the reply filed 10/22/04.

Election/Restrictions

2. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/22/04 is acknowledged.

3. Applicant elected the species of (A) polyetherimides as the amorphous thermoplastic resin in the substrate; (B) aluminum as the reflective metal layer; and (C) plasma-polymerized organosilicone as the haze-prevention layer. Claims 1, 2, 4-11, 15-19, and 21-22 would read on the elected species. It is hereby noted that in the reply, Applicant has included claim 23. However, since claim 23 does not included the elected species of polyetherimides, claim 23 has been withdrawn as directed to a non-elected species.

4. Claims 3, 12-14, 20, and 23 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

5. Claims 1-2, 4-11, 15-19, and 21-22 are being examined as follows.

Claim Rejections - 35 USC § 112

6. In view of the prior Office action of June 30, 2004, the rejection of claim 5, under 35 U.S.C. 112, second paragraph, has been withdrawn due to the Amendments made thereto.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-2, 4-11, 15-19, and 21-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-11, 13-17 and 20-21 of copending Application No. 10/638,145. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims of the copending application disclose all of the limitations as recited in the instant claims. However, the claims of the copending application recite on a data storage medium, whereas the instant claims recite on a reflective article. Thus, the scope of the claims in the copending application and the instant claims overlaps, rendering them obvious over each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1-2, 4-11, 15-19, and 21-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-9, 12-14, and 16 of copending Application No. 10/638,094. Although the conflicting claims are not identical, they are not patentably distinct from each other, because the scope of the claims of the

copending application is broader than that of the instant claims, rendering them obvious over each other.

The claims of the copending application disclose all the limitations as recited in the instant claims.

Furthermore, instant claim 1 recites all of the limitations as recited in claim 1 of the copending application. In addition, instant claim 1 recites an organic volatiles content of less than 1,000 parts per million measured according to ASTM D4526, making it narrower in scope than claim 1 of the copending application. Thus, the scope of the claims of the copending application encompasses that of the instant claims, rendering them obvious over each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-2, 4-11, 15-19, and 21-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-8, and 11-18 of copending Application No. 10/638,100. Although the conflicting claims are not identical, they are not patentably distinct from each other, because the scope of the claims of the copending application is broader than that of the instant claims, rendering them obvious over each other.

The claims of the copending application disclose all the limitations as recited in the instant claims.

Furthermore, instant claim 1 recites all of the limitations as recited in claim 1 of the copending application. In addition, instant claim 1 recites an organic volatiles content of less than 1,000 parts per million measured according to ASTM D4526, making it narrower in scope

than claim 1 of the copending application. Thus, the scope of the claims of the copending application encompasses that of the instant claims, rendering them obvious over each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

11. In view of the prior Office action of June 30, 2004, the rejection of claims 1-2, 4-11, 15-19, and 21-22 under 35 U.S.C. 102(e) as being anticipated by Baal et al. (US Pat. 6,355,723), has been withdrawn due to further consideration.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 1-2, 4-11, 15-19, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baal et al. (US Pat. 6,355,723).

Baal teaches a reflective article and a method of making, the article comprising a substrate (amorphous thermoplastic resin article), a primer coat, and a metallic coat, and a clear coat (see col. 1, ln. 16-22). Baal further teaches the amorphous thermoplastic resin to be polyetherimides (see col. 2, ln. 32-36); the primer coat; the metallic coat to be aluminum; and the clear coat to be plasma-polymerized silicone (see col. 4, ln. 37-56).

Although Baal teaches the plasma-polymerized silicone clear coat to be on the outer surface of the metal layer, instead of between the substrate and the metal layer, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the order of the layers in an article would not have significant patentable weight. This is because whether the silicone-containing layer is between the substrate and the metal layer or outside the metal layer would not change the effects or properties of the article in term hazing prevention. And rearrangement of parts would not impart patentability to the article. See MPEP 2144.04VIC.

Baal further teaches the silicone to be hexamethyldisilazane, and the aluminum layer to be about 70 nm (700 A) (see col. 7, ln. 3-7).

With respect to the heat distortion, volume resistivity, and tensile modulus, since the reference teaches the same article with the same chemical components, the article of the reference would inherently have the same properties as the presently claimed invention.

Response to Arguments

14. Applicant's arguments with respect to claims 1-2, 4-11, 15-19, and 21-22 have been considered but are moot in view of the new ground(s) of rejection.

15. The IDS of 7/27/04 has been initialed by the examiner and enclosed with this Office action.

Contact Information

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt
January 10, 2004

Thao Tran

THAO T. TRAN
PATENT EXAMINER